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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,619	02/12/2004	Suresh Rangaswamy Babu	11884/407501	3957
25693	7590	01/18/2007	EXAMINER	
KENYON & KENYON LLP RIVERPARK TOWERS, SUITE 600 333 W. SAN CARLOS ST. SAN JOSE, CA 95110			RUHL, DENNIS WILLIAM	
			ART UNIT	PAPER NUMBER
			3629	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE		DELIVERY MODE	
3 MONTHS	01/18/2007		PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/776,619	BABU, SURESH RANGASWAMY
Examiner	Art Unit	
Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 October 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 7-9 and 17-33 is/are pending in the application.
- 4a) Of the above claim(s) 26-33 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 7-9, 17-25 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date: _____	6) <input type="checkbox"/> Other: _____

Applicant's response of 10/20/06 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. Newly amended claims 26-33 are now directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The previously prosecuted independent claims 7 and 17 (and dependent claims) were directed towards the detection of product defects that were not previously detected. Now applicant has changed the claims to be directed to the detection of previously stored product defects with associated failure rate statistical limits. This is a changing of the claimed invention that was elected by original presentation. Changing from the detection of previously undetected product defects to the detection of previously detected product defects is a change of invention. If two sets of claims had been originally presented for examination (one directed to the detection of product defects that were not previously detected and one directed to the detection of previously detected product defects with associated failure rate statistical limits) a restriction/election requirement would have been sent out. The reasoning is that the inventive concepts are patentably distinct from each other and the search is different for each set of claims. Applicant is trying to change claimed inventions in the middle of the prosecution of an RCE, which is by definition a continuation of the examination of the invention prosecuted in the originally filed application.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

prosecution on the merits. Accordingly, claims 26-33 are now withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 7-9,17-25, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaroshuk et al. (4253768).

For claims 7,17, Yaroshuk discloses the testing of metallic products to see if they have any defects, so that any corrections that are needed to manufacturing equipment can be made. Disclosed is that metallic surfaces are analyzed by using sensors which

gather product performance data. The collected data is analyzed by a computer to determine if certain performance benchmarks are met (see the summary section where this is discussed, also see column 4, lines 1-column 5, line 31). Defects are noted and then classified according to type. An alert is generated if any product shows any defects and the alert depends on the type of defect noted. With respect to the determination of whether or not the instance related to a previously undetected defect, this is not explicitly disclosed. The examiner notes that in column 5, lines 3-10 it is disclosed that the tubes are sorted "for subsequent analysis" and repair after it has been determined that there is a defect. When one is testing products to identify any product defects, one of ordinary skill in the art is clearly interested in understanding what the defects are and why they happened, so the problems can be fixed. This would include any newly found defects that were not previously detected in "the product line" due to some new problem that is occurring. The reference recognizes that products are sorted "for subsequent analysis" and the examiner takes this as a showing to one of ordinary skill in the art that it is desirable to do an inspection of the products with defects and not just throw them away. One of ordinary skill in the art would have been motivated to inspect the product to confirm what the defect is and why it is occurring, so that any problems that the manufacturer is not yet aware of can be found and addressed. When one of ordinary skill in the art is concerned with detecting defects using the system of Yaroshuk, they also would also find it desirable to determine whether or not the instance of failure is due to a new defect or a previously known defect. One of ordinary skill in the art would have found it obvious to look at the products with defects and determine

whether or not the defect is a previously undetected defect, so that any new problems that may be occurring on the production line may be made aware to those responsible for ensuring the quality of the products that are being manufactured.

For claims 8,18, determining whether or not a previously detected defect is occurring at a rate that exceeds statistical limits is not disclosed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to see if the defect that is noted is occurring at a rate that is higher than an acceptable defect rate. This is done all the time when evaluating possibly defective products and deciding on whether or not to initiate a recall. If it is found that only 0.01% of products have the defect, then a recall may not be necessary due to such low defect rates. However, if the defect rate is higher than some pre-established value (i.e. 10%), that would indicate that there is a high defect rate that would need to be addressed. If a high defect rate is noted (higher than a threshold limit) one of ordinary skill in the art would have found it obvious to generate an alert (a report detailing the defect and the fact it exceeds the limit, a call to a manager to inform them of the defect and the high rate at which the defect is occurring, etc.).

For claims 9,19 not disclosed is diffusion modeling as claimed. When one of ordinary skill in the art notes a defect in a product, where the product has already been distributed or sold and the defect is of a nature that requires some action, one of ordinary skill in the art would have found it obvious to figure out how many products were distributed or sold so that if they need to be recalled and cannot be sold, the

original manufacturer can estimate the cost of a recall or can notify their distributors to tell them to pull the products off the shelves.

For claims 20,25, the performance data is collected from a source as claimed.

The data must either come from internal or external to the company. These are the only two possibilities that exist so not matter where the data is collected from, the claim is satisfied by the prior art.

For claims 21-24, the claims still have a scope that allows for the data to be collected internally or externally. Claims 21 and 22 do not further limit where the data is collected from, these claims are just further defining who the internal or external entity is. The prior art satisfies what is claimed.

4. Applicant's arguments filed 10/20/06 have been fully considered but they are not persuasive. Applicant has argued that one of ordinary skill in the art would not find it obvious to determine if a defect is a previously undetected defect in a system that is designed to look for defects and generate alerts in response to finding a defect. The position of the examiner is basically that one of ordinary skill in the art who is concerned with detecting product defects is not just concerned with those defects that were previously noted, but is also concerned with any new defects that arise from other problems occurring on the production line that they are not yet aware of. Even in the system of Yaroshuk, the defects that are being looked for had to be initially detected at some point in time. There had to be a first time when those defects were noted. One of ordinary skill in the art is not just interested in those defects that are already known,

but is interested in all defects, especially newly found ones. The examiner does not feel that it is reasonable to say that one of ordinary skill in the art would not be motivated to figure out if a defect is a previously undetected defect, they would be interested in all defects, those previously detected and those not previously detected. The argument is found to be non-persuasive.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL  
PRIMARY EXAMINER